



#25 / Appeal Brief
Wm Morgan
7/1/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Benjamin J. Kwitek

Group Art Unit: 3711

Serial No.: 09/173,445

Examiner: Blau

Filed : 10/16/98

Title : GOLF GRIP

APPEAL BRIEF

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Sir:

REAL PARTY IN INTEREST

Benjamin J. Kwitek is the real party in interest in the above referenced patent application.

RELATED APPEALS AND INTERFERENCES

The application was previously appealed and a Decision was issued November 29, 2001. New grounds for rejection were issued and the present appeal relates to the new grounds for rejection. Neither Appellant's representative nor Appellant is aware of any other related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 3, 7-10, 14 and 21-27 are currently pending in the above referenced application. Appellant accordingly Appeals the Examiner's Final Rejection of claims 1, 3, 7-10, 14 and 21-27 which is as follows:

1. Claims 1, 3, 7-10, 14 and 21-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,730,669 to Huang ("Huang") in view of U.S. Patent No. 5,555,584 to Moore, III et al. ("Moore").

STATUS OF AMENDMENTS

No amendments after final rejection have been filed. All amendments have been entered.

SUMMARY OF THE INVENTION

The golf grip 110 is designed with a responsive and relatively viscoelastic hand surface 112. The viscoelastic hand surface 112 provides golfers with a soft and individually conforming hand surface. (Page 7, lines 9-13)

The hand surface 112 of the present grip is an ultra-soft material. This also endows the product with an inherent tactile feel. The grip, as described herein, provides a tacky surface, essential and beneficial for gripping. The ultra-soft hand surface can be measured in terms of hardness by the Shore A Durometer Test. The present grips have durometers in this scale between approximately 2 and 40. (Page 7, lines 18-24)

The golf grip 110 includes a shell 114 shaped and dimensioned to fit about the proximal end 16 of a golf club shaft 18. As such, the shell 114 includes an inner surface shaped and dimensioned to fit about the golf club shaft 18. The outer surface 34 of the shell 114 is shaped and dimensioned to receive the viscoelastic hand surface 112. (Page 8, lines 1-8.) The shell 114 is preferably constructed from a variety of soft elastomers, such as, rubber or synthetic rubber-like materials. (Page 8, lines 13-16)

The shell 114 includes a central section 120 about which the viscoelastic hand surface 112 is positioned. The proximal end 122 and distal end 124 of the shell 114 are respectively provided with lips 126, 128 circumferentially extending about the shell 114. The lips 126, 128 are shaped and dimensioned to retain the viscoelastic hand surface 112 about the central section 120 of the shell 114. (Page 10, lines 1-9)

The viscoelastic hand surface 112 is a viscous liquid material 136 contained in an elastomeric bag 138. The viscous liquid 136 is preferably a silicone gel or oil and the elastomeric bag 138 is

preferably a silicone sheet or a thermoplastic elastomer. (Page 10, lines 10-14)

The viscoelastic hand surface 112 is adhered to the central section 120 of the shell 114 with an adhesive. The attachment could also be accomplished by compressing both ends of the elastomeric bag 138 at the proximal and distal lips 126, 128 with a chamber and gasket system.

(Page 10, lines 18-22)

The present golf grip 110 is designed for placement about the proximal end of the golf club shaft 18 in much the same manner that conventional golf grips are placed about the proximal end of a golf club shaft. As such, the present golf grip 110 may be used as a replacement grip for worn grips or grips placed upon a golf club during the manufacture of the golf club. (Page 11, lines 1-7)

In accordance with the preferred embodiments of the present invention, the soft polymer material forming the hand surface 112 is approximately 1/16" - 1/4" thick and the elastomeric shell 114 is less than 1/4" thick. The present grip 110 will, therefore, have substantially the same dimensions as conventional golf grips. (Page 11, lines 8-13)

The provision of a responsive viscoelastic polymer hand surface provides golfers with a soft and individually conforming hand surface. In this way, the present grips are designed to enhance the feel of the golf club, and, thereby, improve the golfer's ability to strike a golf ball. A soft grip surface prompts the golfer to use a softer touch in putting and helps to avoid excessive squeezing on other clubs. The soft viscoelastic hand surface also reduces hand fatigue associated with gripping a hard hand surface. In addition, the use of an elastomeric shell with a responsive viscoelastic polymer material encased therein makes the present golf grip easy to manufacture and place upon the proximal end of a golf club shaft for use by a golfer. (Page 13, lines 7-19)

ISSUES

1. Whether claims 1, 3, 7-10, 14 and 21-27 stand properly rejected under 35 U.S.C. § 103 as being unpatentable over Huang in view of Moore.

GROUPING OF THE CLAIMS

All of the claims stand or fall together.

ARGUMENTS

I. CLAIMS 1, 3, 7-10, 14 AND 21-27 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103 BASED UPON HUANG IN VIEW OF MOORE

Claim 1 defines a grip adapted for attachment to an implement including a handle. The grip includes a longitudinally extending tubular shell having an inner surface shaped and dimensioned for attachment to the handle of the implement. The tubular shell further includes an outer surface. In addition, the grip includes a viscoelastic hand surface having a thickness secured about the outer surface of the tubular shell. The viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag. The tubular shell includes a first end and second end. The tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and an outwardly extending second lip adjacent the second end of the tubular shell. The first and second lips define a central section within which the viscoelastic hand surface is positioned. The viscoelastic hand surface has a thickness between approximately 1/16" and 1/4" and the central section has a depth as defined by the first and second lips which is substantially the same as the thickness of the viscoelastic hand surface such that the first and second lips retain the viscoelastic hand surface in position on the tubular shell. Claim 21 includes similar limitations and also stands rejected based upon the disclosures of Huang in view of Moore.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the

subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . . This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a prima facie case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j).

In contrast to the claimed invention, Huang discloses a hand grip constructed from a felt/polyurethane strip S which is positioned about a sleeve 60. The sleeve 60 is constructed from synthetic plastic foam or rubber. The sleeve 60 is formed with a cap 62 adjacent the upper portion of the sleeve 60 and a guide cylinder 64 adjacent the lower portion of the sleeve 60. Other than defining the starting and stopping positions for the strip S, the function of the cap 62 and the guide cylinder 64 is not explicitly defined (Col. 6, lines 33-35, states, "The strip S extends from the underside of the cap 62 to guide cylinder 64").

As both the Examiner and the Board of Patent Appeals and Interferences have noted, Huang fails to disclose a handle grip having the claimed viscoelastic hand surface. The appealed

rejection attempts to remedy this deficiency by applying the teachings of Moore. Appellant respectfully disagrees with the rejection based upon Huang and Moore as the proposed combination does not provide for a reasonable likelihood of success and the cited prior art fails to disclose or suggest each of the claimed limitations. O

As stated above, Huang does disclose a hand grip constructed from a polyurethane/felt strip S which is positioned about a sleeve 60. Huang also does disclose that the sleeve 60 is formed with a cap 62 adjacent the upper portion of the sleeve 60 and a guide cylinder 64 adjacent the lower portion of the sleeve 60. The figures of Huang further tend to suggest that the cap 62 and the guide cylinder 64 are of a thickness similar to that of the wrap S. In addition, Moore does disclose the utilization of a gel type hand grip with tennis rackets, golf clubs, etc. However, nothing in the disclosures of Huang or Moore provides a sufficient basis for rendering obvious a viscoelastic grip which includes an outwardly extending first lip and an outwardly extending second lip, wherein the viscoelastic hand surface has a thickness between approximately 1/16" and 1/4" and the central section of the grip has a depth as defined by the first and second lips which is substantially the same as the thickness of the viscoelastic hand surface such that the first and second lips retain the viscoelastic hand surface in position on the tubular shell. O

In particular, Huang discloses that the grip should be constructed with a polyurethane layer of about 0.4 millimeters and a felt layer of about 0.9 millimeters (see Huang Col. 4, lines 61-65). The cap 62 and guide cylinder 64, therefore, have a similar depth as disclosed with reference to Figure 13 of Huang. The pending claims define a viscoelastic hand surface having a thickness between approximately 1/16" (1.59 mm) and 1/4" (6.35mm), with first and second lips of substantially the same thickness. That is, at its lowest end, the claims of the present application define a viscoelastic

hand surface (and first and second lips) having a thickness of at least approximately 1.59 millimeters. This is substantially thicker than the 1.3 millimeter thickness offered by Huang. Moore does disclose a gel material within the claimed range, but fails to disclose or suggest the need for first and second lips as claimed. O

In view of Huang's failure to disclose a grip offering dimensions similar to those required in accordance with the claimed invention and Huang's failure to consider the problems associated with the manufacture of a viscoelastic hand surface, and further considering the very basic proposition of whether it is in fact obvious to replace the polyurethane/felt strip of Huang with a gel material as disclosed by Moore, it Appellant's opinion the combination proposed in the outstanding rejection takes far too simple a view of the problems associated with the application of a gel material to a golf grip. Specifically, Moore discloses at Column 10, lines 61-63, that the gel material should be rolled such that it has a thickness of approximately 1/8" (3.17 mm) to 1/4" (6.35 mm). That is, the gel material disclosed by Moore is within the range claimed in accordance with the present invention. O

However, the thickness of the gel material disclosed by Moore is substantially thicker than the hand surface contemplated by Huang. As mentioned above, Huang discloses that the grip should be constructed with a polyurethane layer of about 0.4 millimeters and a felt layer of about 0.9 millimeters (see Huang Col. 4, lines 61-65), substantially thinner than the gel material proposed by Moore. O

Application of the gel material of Moore to the sleeve disclosed by Huang as proposed in accordance with the outstanding rejection, would result in an entirely unworkable grip with the gel material overhanging the cap 62 and guide cylinder 64 disclosed by Huang. The overhanging gel material would be cumbersome to grip and the likelihood the gel material would slip relative to the O

sleeve 60 is very great given the lack of reinforcement to either the top or the bottom of the gel material.

In fact, it is Appellant's opinion this is one of the inherent flaws in the overall design of the grip disclosed by Moore. While Moore does appreciate the benefits of a gel grip, Moore fails to appreciate the gel material will flow under the greater forces applied while playing tennis or golf and, therefore, requires retaining members to keep the gel material properly positioned for use as a grip. As shown with reference to Figures 6, 7 and 8 of Moore, the gel material is simply laid upon the tennis racket with no apparent consideration for the very real stresses pulling the gel material along the length of the tennis racket. Without such supports, the gel material will certainly flow during use, moving the racket relative to the hand of the user in a very undesirable manner. 0

This movement is exactly the likely result when the gel material is applied to the grip structure disclosed by Huang. As nothing in the cited prior art suggests the need for retaining a gel material when utilized as a hand surface for a golf grip (Huang uses a polyurethane/felt wrap which does not exhibit flow characteristics similar to those encountered with a gel material and, therefore, requires no restraining structure) any proposition for increasing the thickness of the cap 62 and guide cylinder 64 to provide a retaining system for the gel material is entirely unsupported by the prior art and it would not be obvious to increase the thickness of the cap 62 and cylinder 64 so as to accommodate the increase thickness of the grip disclosed by Moore.

While Appellant asserts the prior art fails to disclose a retaining function, the Board of Patent Appeals and Interferences and the Primary Examiner have adopted a different understanding as to the function of the cap 62 and guide cylinder 64. However, and as is the case in the present situation, the parties differ in their interpretation of the function performed by the cap 62 and the

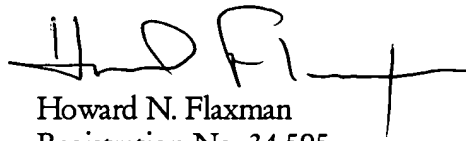
guide cylinder 64. Appellant understands the cap 62 and guide cylinder 64 top function merely as a guide in respectively defining the upper and lower extent of the grip. The understanding is based upon the fact that the polyurethane/felt strip S is substantially rigid and will not move along the sleeve 60 once it is wrapped thereabout. As such, the only function which might possibly be assigned to the cap 62 and guide cylinder 64 is that of a guide defining the upper and lower extent of the grip. In contrast to the understanding of Appellant, both the Board for Patent Appeals and Interferences and the Examiner assign an inherent retaining function to the cap 62 and the guide cylinder 64. As the strip S will not move in any noticeable manner along the length of the sleeve 60, Appellant does not understand what in fact the cap 62 and guide cylinder 64 are retaining. As such, since the cap 62 and guide cylinder 64 provide no retaining function, the basis for the outstanding rejection is improper and the rejection must be reversed.

With the foregoing in mind, it is Appellant's opinion the Examiner has failed to show a reasonable expectation of success in modifying Huang based upon the teachings of Moore and is demonstrating that the prior art reference (or references when combined) teaches or suggests all the claim limitations. Specifically, nothing teaches the need for retaining members when utilizing a gel material within a golf grip and, therefore, it follows that nothing in the cited prior art discloses or suggests the claimed thickness relationship between the viscoelastic hand surface and the first and second lips. It is, therefore, Appellant's opinion that claims 1 and 21 overcome the prior art of record and Appellant respectfully requests that the outstanding rejections be reversed.

II. CONCLUSION

In conclusion, Appellant has now shown that the references cited in the Office Action neither disclose nor suggest the claimed grip. Therefore, it is respectfully requested the outstanding rejection be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'H. N. Flaxman', with a long horizontal stroke extending to the right.

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APPENDIX

CLAIMS ON APPEAL

1. A grip adapted for attachment to an implement including a handle, comprising:
a longitudinally extending tubular shell including an inner surface shaped and dimensioned for attachment to the handle of the implement and an outer surface; and
a viscoelastic hand surface having a thickness secured about the outer surface of the tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag; and wherein the tubular shell includes a first end and a second end, and the tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and a outwardly extending second lip adjacent the second end of the tubular shell, the first and second lips defining a central section within which the viscoelastic hand surface is positioned, wherein the viscoelastic hand surface has a thickness between approximately 1/16" and 1/4" and the central section has a depth as defined by the first and second lips which is substantially the same as the thickness of the viscoelastic hand surface such that the first and second lips retain the viscoelastic hand surface in position on the tubular shell.
3. A grip according to claim 1, wherein the first lip extends about the circumference of the tubular shell adjacent the first end of the tubular shell and the second lip extends about the circumference of the tubular shell adjacent the second end of the tubular shell.

7. A grip according to claim 1, wherein the viscous liquid material is a silicone gel or silicone oil.
8. A grip according to claim 1, wherein the tubular shell is a soft elastomer.
9. A grip according to claim 1, wherein the grip is shaped and dimensioned for use as a golf club grip.
10. A grip according to claim 9, wherein the tubular shell is substantially cylindrical shaped with a slight taper.
14. The apparatus according to claim 13, wherein the workpiece has a longitudinal axis oriented perpendicular to a direction of blade travel during slicing, and further comprising workpiece guides for maintaining the longitudinal axis of the workpiece in a substantially perpendicular orientation to the direction of blade travel during slicing.

21. A grip adapted for attachment to an implement including a handle, comprising:
- a longitudinally extending tubular shell including an inner surface shaped and dimensioned for attachment to the handle of the implement and an outer surface; and
- a viscoelastic hand surface having a thickness between approximately 1/16" and 1/4" secured about the outer surface of the tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag; and wherein the tubular shell includes a first end and a second end, and the tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and a outwardly extending second lip adjacent the second end of the tubular shell, the first and second lips being substantially the same size as the thickness of the viscoelastic hand surface such that the first and second lips are being shaped and dimensioned to retain the viscoelastic hand surface in position on the tubular shell.
22. A grip according to claim 21, wherein the first lip extends about the circumference of the tubular shell adjacent the first end of the tubular shell and the second lip extends about the circumference of the tubular shell adjacent the second end of the tubular shell.
23. A grip according to claim 21, wherein the viscoelastic liquid material is a silicone gel or silicone oil.
24. A grip according to claim 21, wherein the tubular shell is a soft elastomer.

25. A grip according to claim 21, wherein the grip is shaped and dimensioned for use as a golf club grip.

26. A grip according to claim 25, wherein the tubular shell is substantially cylindrical shaped with a slight taper.

27. A grip according to claim 25, wherein the tubular shell is a soft elastomer.